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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,010	06/23/2003	Bruce Edward Stuckman	1033-T00531	7678

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2178

MAIL DATE	DELIVERY MODE
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06/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/602,010

Applicant(s)

STUCKMAN ET AL.

Examiner

JOSHUA D. CAMPBELL

Art Unit

2178

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-22, 24-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-22, 24-35 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 3/20/2009.
2. Claims 1-7, 9-22, 24-35, and 37 are pending in this case. Claims 1 and 24 are independent claims. Claims 1 and 24 have been amended.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 24-34 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. **A collection of fields (i.e. electronic form), per se, is non-functional descriptive material regardless of whether or not it is stored on a usable medium, thus it is considered to be merely an abstract idea and is rejected under 35 U.S.C. 101 as being a non-patentable abstract idea.**

Proper correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4, 6, 7, 9-22, 24-27, 29-33, and 35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over BountyQuest Website (hereinafter BQ, www.bountyquest.com, 5/15/2001, downloaded via archive.org on 11/1/2005, pages 1-29 listed in a previous action – please note that the examiner references page numbers at bottom of the BountyQuest reference) in view of Utsumi (European Patent No. EP 1 160 708 A1, published December 5, 2001, listed in previous action).

Regarding independent claim 1, BQ discloses an electronic form to display criteria for limitations of a particular patent as they apply to another source (different patent, reference, product) which allows a user to input a source and how the source meets the criteria of the limitations of the patent (page 10, “What do I need to submit?” and pages 15 and 16 of BQ). BQ also discloses that previously cited sources are displayed to the users (pages 25-29, “Information we already have, such as...” of BQ). BQ does not explicitly disclose that the source and the sources information deal specifically with infringement claims. However, Utsumi discloses allowing users to input

information sources in reference to a patent and its claimed limitations for the purposes of infringement analysis (page 2, paragraph 0006-0007 of Utsumi). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of BQ for evaluating a source against patent claims with the teachings of Utsumi for evaluating sources for infringement analysis because it would have allowed for rights holders to efficiently collect information about the infringement on their rights.

Regarding dependent claims 2-4, 6, and 7, BQ discloses that a form comprises a plurality of input boxes, each associated with a specific criteria (claim limitations, reference information, etc.), the criteria being displayed in display portions which are adjacent to the input boxes for that criteria, the input boxes being capable of receiving input from the user about both the source and how the source applies to the claim limitation (first and second information) (pages 15 and 16 of BQ).

Regarding dependent claim 9, BQ discloses that the form is a web form (pages 15 and 16 of BQ).

Regarding dependent claims 10 and 11, BQ discloses that the source is identified by product name and company (Title and Publisher) (page 10, "What do I need to submit?" and pages 15 and 16 of BQ).

Regarding dependent claim 12, BQ discloses receiving submissions from multiple users via the form and evaluating the submissions to determine whether or not they are on-point and additionally determining which on-point submission was first based on the date and time (timestamp) it was received (page 8, bullet point "5. Sit

back..."and page 12, "What happens if more than one person submits a correct response?" of BQ).

Regarding dependent claim 13, BQ does not explicitly disclose that the reviewer is a patent attorney. However, Utsumi discloses that the evaluation of the submissions is performed by a patent attorney (page 4, paragraph 0037 of Utsumi). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of BQ for evaluating a source against patent claims with the teachings of Utsumi for evaluating sources for infringement analysis because it would have allowed for rights holders to efficiently collect information about the infringement on their rights.

Regarding dependent claim 14 and 16, BQ discloses compensating the user for the first received on-point submission with a fixed fee (page 7, "What the heck is a bounty, anyway?" of BQ).

Regarding dependent claims 15 and 17, BQ does not explicitly disclose that the compensation is conditioned on/commensurate with the compensation from a deal with the infringement target. However, Utsumi discloses that the compensation to the information provider is commensurate with the compensation from a deal with the infringement target (page 4, paragraph 0037-page 5, paragraph 0041 of Utsumi). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of BQ for evaluating a source against patent claims with the teachings of Utsumi for evaluating sources for infringement analysis

because it would have allowed for rights holders to efficiently collect information about the infringement on their rights.

Regarding dependent claims 18 and 19, BQ discloses recording a timestamp (date and time) and sending the user an acknowledgement including the timestamp (Page 15, bullet point "1. Fill out the form..." of BQ).

Regarding dependent claims 20 and 21, BQ discloses that the form and submission is performed on the Internet (page 3, "BountyQuest – Main Page" an Internet provided web page). BQ does not explicitly disclose that the network can be an intranet. However, Utsumi discloses the use of a network defined as either an intranet or Internet for handling submissions of the information (page 3, paragraphs 0014 and 0019 of Utsumi). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of BQ for evaluating a source against patent claims with the teachings of Utsumi for evaluating sources for infringement analysis because it would have allowed for rights holders to efficiently collect information about the infringement on their rights.

Regarding dependent claim 22, BQ discloses that the user input is graphical input (page 10, "What do I need to submit?" and pages 15 and 16 of BQ).

Regarding independent claim 24 and dependent claims 25-27, 29, 30, 32, and 33, the claims incorporate substantially similar subject matter as claims 1-7, 9, and 22. Thus, the claims are rejected along the same rationale as claims 1-7, 9, and 22.

Regarding dependent claim 31, BQ discloses that the input boxes accept natural language textual input (page 10, "What do I need to submit?" and pages 15 and 16 of BQ).

Regarding dependent claim 35, BQ discloses a registration and login process (trust mechanism) (page 8, "Why should I register with BountyQuest?" of BQ).

7. Claims 5 and 28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over BountyQuest Website (hereinafter BQ, www.bountyquest.com, 5/15/2001, downloaded via archive.org on 11/1/2005, pages 1-29 listed in a previous action – please note that the examiner references page numbers at bottom of the BountyQuest reference) in view of Utsumi (European Patent No. EP 1 160 708 A1, published December 5, 2001, listed in previous action) as applied to claims 4 and 27, further in view of Bramson ("Glossary of Intellectual Property Terms," published in 2001).

Regarding dependent claims 5 and 28, neither BQ nor Utsumi disclose that the form is arranged with display portions (claim limitations) in the first column and input boxes in the second column. However, Bramson discloses the notoriously well-known method in the intellectual property art of a claim chart, which consists of the claim limitations (display portions) in the first column and the comparison of infringing information in the second and/or third column (page 3, definition of "Claim Chart" of Bramson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of BQ and Utsumi with the notoriously well-known teachings of Bramson by formatting the form like a claim chart

because it would have allowed the user to more easily compare the correspondence of the two sets of information visually.

8. Claims 34 and 37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over BountyQuest Website (hereinafter BQ, www.bountyquest.com, 5/15/2001, downloaded via archive.org on 11/1/2005, pages 1-29 listed in a previous action – please note that the examiner references page numbers at bottom of the BountyQuest reference) in view of Utsumi (European Patent No. EP 1 160 708 A1, published December 5, 2001, listed in previous action) as applied to claims 4 and 27, further in view of Andrews et al. (hereinafter Andrews, US Patent Number 5,243,519, issued on September 7, 1993).

Regarding dependent claims 34 and 37, neither BQ nor Utsumi explicitly disclose translating the criteria from a first language to a second language. However, Andrews discloses that any information for any application can be translated to a specific language and reinserted into its rightful position (column 10, line 59-column 11, line 8 of Andrews). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of BQ and Utsumi with the notoriously well-known teachings of Andrews because it would have allowed users to operate the system in multiple languages.

Response to Arguments

9. Applicant's arguments filed 3/20/2009 have been fully considered but they are not persuasive.

Regarding applicant's arguments on page 7, in reference to the 101 rejection, the examiner maintains that the rejection is proper and must be maintained. A collection of fields (i.e. electronic form), per se, is non-functional descriptive material regardless of whether or not it is stored on a usable medium, thus it is considered to be merely an abstract idea and is rejected under 35 U.S.C. 101 as being a non-patentable abstract idea.

Regarding applicant's arguments on pages 7-10, in reference to the limitation that states, "...one or more currently identified infringement targets and accepts and accepts an infringement submission including first user input to identify an additional infringement target," the examiner maintains that the rejection is proper and must be maintained. BQ discloses an electronic form to display **criteria for limitations** of a particular patent **as they apply to another source** (different patent, reference, product) which allows a **user to input a source and how the source meets the criteria of the limitations of the patent** (page 10, "What do I need to submit?" and pages 15 and 16 of BQ). BQ also discloses that **previously cited sources (targets that meet the criteria of the limitations) are displayed to the users** (pages 25-29, "Information we already have, such as..." of BQ). BQ does not explicitly disclose that the source and the sources information deal specifically with infringement claims, but they do meet the limitations required to equate them to the infringement information. In addition,

Utsumi discloses allowing users to input information sources in reference to a patent and its claimed limitations for the purposes of **infringement analysis (page 2, paragraph 0006-0007 of Utsumi)**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of BQ for evaluating a source against patent claims with the teachings of Utsumi for evaluating sources for infringement analysis because it would have allowed for rights holders to efficiently collect information about the infringement on their rights. Thus, rejection is proper and must be maintained.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. CAMPBELL whose telephone number is (571)272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua D Campbell/
Primary Examiner, Art Unit 2178
June 15, 2009